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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/774,801   | 02/09/2004  | Yves Leclair         | ESSR:060USD1        | 9054             |
| 32425  | 7590        | 10/17/2005           | EXAMINER .          |                  |
| FULBRIGHT & JAWORSKI L.L.P.<br>600 CONGRESS AVE.<br>SUITE 2400<br>AUSTIN, TX 78701 |             |                      | MARKHAM, WESLEY D   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1762                |                  |

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/774,801 | Applicant(s)<br>LECLAIRE ET AL |  |
|                              | Examiner<br>Wesley D. Markham | Art Unit<br>1762               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005 and 09 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20, 21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/057,472.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Acknowledgement is made of the amendments filed by the applicant on 5/6/2005 and 8/9/2005, in which the specification of the instant application was amended, a substitute abstract of the disclosure was submitted, one (1) replacement sheet of drawings was submitted, Claims 20, 21, and 23 – 26 were amended, Claim 22 was canceled, and Claims 27 and 28 were added. **Claims 20, 21, and 23 – 28** are currently pending in U.S. Application Serial No. 10/774,801, and an Office action on the merits follows.

### ***Drawings***

2. The one (1) replacement sheet of drawings filed on 5/6/2005 is approved by the examiner. As such, the objection to the drawings set forth in paragraph 4 of the previous Office action (i.e., the non-final Office action mailed on 11/4/2004) is withdrawn.

### ***Specification***

3. The objections to the specification, including the abstract of the disclosure, set forth in paragraphs 5 and 6 of the previous Office action, are withdrawn in light of the applicant's amendment to capitalize the trademark ORMA and submission of an acceptable single paragraph abstract.

***Claim Objections***

4. The objection to Claims 21 – 26 set forth in paragraph 7 of the previous Office action is withdrawn in light of the applicant's amendment to correct the spelling of the word "ophthalmic".

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. The rejection of Claims 23 – 25 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, set forth in paragraph 10 of the previous Office action, is withdrawn in light of the applicant's amendment to clarify the antecedent basis issue raised by the examiner.

***Claim Observations***

7. Regarding Claims 24 and 26, the examiner has reasonably interpreted the features associated with the term "preferably" in each of the claims to be exemplary, not limiting.
8. Independent Claim 20, from which Claims 21 and 23 – 28 depend, has been amended by the applicant to require that the impregnatable thin film be produced from a polymer material obtained from a latex and have a thickness of less than 5

microns. As such, the 35 U.S.C. 102 rejections based on Chen et al. (see paragraph 15 of the previous Office action), Welch et al. (see paragraph 17 of the previous Office action), and Goepfert et al. (see paragraph 19 of the previous Office action) are withdrawn because the film thickness values taught by each of the references (10 to 75 microns in Chen et al., 5 to 100 microns in Welch et al., and 450 microns in Goepfert et al.) fall outside of the applicant's claimed range of film thicknesses.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 20, 21, and 23 – 28** are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (USPN 5,770,259) for the reasons set forth in paragraph 21 of the previous Office action and below.
11. Regarding amended independent Claim 20 and new Claim 28, Parker et al. also teaches that the polymeric thin film has a thickness of, for example, 1 micron (Col.5, line 67 – Col.6, line 3), which falls within the applicant's claimed range of less than 5 microns (Claim 20), particularly from 0.5 to 2 microns (Claim 28).

12. **Claims 20, 23 – 25, 27, and 28** are rejected under 35 U.S.C. 102(b) as being anticipated by Guest et al. (USPN 5,013,608) for the reasons set forth in paragraph 23 of the previous Office action and below.
13. Regarding amended independent Claim 20 and new Claim 28, Guest et al. also teaches that the thin film produced from a polymer material has a thickness of less than about 10 microns, for example 1 micron (Col.9, line 59 – Col.10, line 22), which falls within the applicant's claimed range of less than 5 microns (Claim 20), particularly from 0.5 to 2 microns (Claim 28).
14. Claims 20 and 23 – 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Maisonnier et al. (WO 00/50533 A1). Please note that this document is in the French language. Therefore, US 2002/0128339 A1, which is an English language publication of the continuation of WO 00/50533 A1, is being used as an effective English language translation.
15. Regarding independent **Claim 20**, Maisonnier et al. teaches an ophthalmic lens comprising an optically transparent substrate (Abstract, paragraphs [0085] – [0091]), wherein the substrate is coated, on at least one face, with an optically transparent impregnatable thin film adhering to the substrate and produced from a polymer material obtained from a latex (paragraphs [0001], [0025] – [0035], and [0078] – [0086]), the film having a thickness of less than 5 microns (paragraph [0084]) and comprising an "impregnation composition" (paragraphs [0028], [0035], and [0051] – [0076], which shows that the film contains various dyes and agents and a dilution

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medium such as water, or in other words, an "impregnation composition").

Regarding **Claims 23, 25, and 27**, Maisonnier et al. teaches that the film contains various dyes and agents and a dilution medium such as water (paragraphs [0028], [0035], and [0051] – [0076]). Regarding **Claim 24**, the film of Maisonnier et al. comprises various components that are reasonably considered to be "an agent for retaining the additive" (paragraphs [0043], [0047], [0048]). Regarding **Claim 26**, the film of Maisonnier et al. is coated with an anti-scratch coating (paragraphs [0092] – [0094]).

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. **Claims 20, 21, and 23 – 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Welch et al. (US 2002/0009599 A1).

19. Specifically, Welch et al. teaches all the limitations of Claims 20, 21, and 23 – 27 as set forth in paragraph 17 of the previous Office action, except for a film thickness of less than 5 microns. However, the range of film thicknesses taught by Welch et al. (e.g., 5 to 200 microns, preferably 5 to 100 microns) (paragraph [0067]) infinitesimally approaches the range of film thicknesses claimed by the applicant (less than 5 microns). Therefore, it would have been obvious to one of ordinary skill in the art to form the film of Welch et al. to have a thickness just slightly less than 5 microns with the reasonable expectation of success and obtaining similar results (i.e., producing a photochromic polyurethane coating having a sufficient quantity photochromic compounds, regardless of whether the coating thickness is 5 microns (as taught by Welch et al.) or slightly less than 5 microns (e.g., 4.999 microns)).

Please note that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties (*Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985)). In this case, one skilled in the art would have reasonably expected a coating having a thickness of 5 microns, a value outside the claimed range but taught by Welch et al., to have the same properties as a coating having a thickness of 4.999 microns, a value within the claimed range.

20. **Claims 20, 21, and 23 – 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber et al. (USPN 5,316,791) in view of Parker et al. (USPN 5,770,259) and Goepfert et al. (USPN 4,454,170) for the reasons set forth in paragraph 27 of the previous Office action and below.
21. Regarding amended independent Claim 20 and new Claim 28, the aforementioned combination of references also teaches that the thin film produced from the polymer material has a thickness of, for example, about 2 microns (Col.5, lines 39 – 50 of Farber et al.), which falls within the applicant's claimed range of less than 5 microns (Claim 20), particularly from 0.5 to 2 microns (Claim 28).

### ***Response to Arguments***

22. Applicant's arguments filed on 5/6/2005 have been fully considered but they are not persuasive.
23. Regarding the rejections based on Welch et al., the applicant argues that Welch et al. discloses direct production for forming a polyurethane coating, and there is no disclosure in this reference to form a polyurethane coating from a polyurethane latex. Additionally, the applicant argues that Welch et al. only incidentally mentions impregnating the cured coating with a photochromic impregnation composition and does not disclose an impregnation composition comprising a dispersion of a dyeing additive in a diluting medium (e.g., an impregnation composition for an already formed coating).

24. In response, these arguments are not convincing. To begin, the examiner notes that the patentability of a product does not depend on its method of production. If the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (*In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)). In this case, the applicant's claims recite that the thin film is produced from a polymer material obtained from a latex, particularly a polyurethane latex. However, the end product of the applicant's claims is simply a polymeric, particularly polyurethane, film, which is taught by Welch et al. The fact that the applicant's polyurethane film was obtained from a latex (i.e., an aqueous medium) while the polyurethane film of Welch et al. was obtained by a different method does not structurally distinguish the applicant's claimed product from the product of Welch et al. Likewise, the film of Welch et al. contains any number of various solvents (i.e., a diluent medium) and additives (e.g., dyes, photochromic dyes, etc.) (see paragraphs [0057] – [0065] and the examples), which together are reasonably interpreted to be an "impregnation composition". In the context of the applicant's claimed product, it is irrelevant whether the "impregnation composition" is present in the coating composition itself or added to the preformed coating because the end product is the same (i.e., a coated ophthalmic lens having solvent(s) and additive(s)/dye(s) in the coating).

25. Regarding the rejections based on Parker et al., the applicant argues that Parker et al. merely discloses a coloring process of an ophthalmic lens which includes coating a transparent substrate with a resin based colored coating. The applicant states that

Parker et al. does not disclose an optically transparent impregnatable thin film. In response, Parker et al. clearly teaches that the film transmits light (i.e., is transparent) (Col.4, lines 24 – 27 and 51 – 54) and has a thickness in the range claimed by the applicant (Col.6, lines 1 – 3) (i.e., is a “thin film”). Therefore, it appears that the applicant is arguing that the film of Parker et al. is not “impregnatable”. However, as noted by the applicant, the coating of Parker et al. is resin based. It is the examiner’s position that every resin based film is, to some extent, “impregnatable” under the appropriate conditions (e.g., high temperatures, long exposure time, the appropriate solvent, etc.).

26. Regarding the rejections based on Guest et al., the applicant argues that Guest et al. does not teach that the film is produced from a polymer material obtained from a latex. This argument is not convincing. For example, the film of Guest et al. is produced from a polymer material (see Cols.4 – 6, which show the polymeric components of the resin coating) in an aqueous suspension (Col.6, lines 26 – 30). As such, the film is produced from a polymer material obtained from a latex. Alternatively and as noted above, the patentability of a product does not depend on its method of production. In this case, Guest et al. teaches a polymeric coating, albeit a polymeric coating containing inorganic (i.e., Si) as well as organic components. The end product of the applicant’s claims is simply a polymeric film, which is taught by Guest et al. The fact that the applicant’s polymeric film was obtained from a latex while the polymeric film of Guest et al. may have been obtained by a different method does not structurally distinguish the applicant’s

claimed product from the product of Guest et al. The applicant also argues that the coloring bath of Guest et al. does not appear to contain any retaining agent. In response, this argument is not convincing. Guest et al. teaches that the coating composition contains a variety of compounds, including a crosslinking agent and a tintability enhancing compound (see Cols.7 – 8). Additionally, Guest et al. teaches that the dye is absorbed into the coating to tint the coating (Col.10, lines 40 – 59). As such, the dye is “retained” in the coating, and any portion / component of the coating composition that keeps the dye in the coating is reasonably considered to be “an agent for retaining the additive”.

27. Regarding the 35 U.S.C. 103(a) rejections based on the combination of Farber et al., Parker et al., and Goepfert et al., the applicant argues that (1) none of the references teaches an “impregnatable thin film” or such film “being produced from a polymer material obtained from a (polyurethane) latex, (2) there is not motivation to combine the references, as Parker et al. would, at most, suggest forming the primer layer from a curable and polymerizable composition containing a colorant and not the claimed “impregnatable thin film”, (3) Goepfert et al. discloses a process for coloring a polyurethane sheet, which is not applicant’s claimed “thin film”, (4) Farber et al. never envisages a tinted impact resistant layer, and (5) there is not reasonable expectation of success.

28. These arguments are not convincing. In response to applicant's arguments against the references individually (e.g., Goepfert et al. discloses a process for coloring a polyurethane sheet, which is not applicant’s claimed “thin film”, and Farber et al.

never envisages a tinted impact resistant layer), one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding argument (1), Farber et al. teaches a primer layer produced from an aqueous polyurethane dispersion (i.e., a latex) and having a thickness in the range claimed by the applicant. This is exactly the same coating as that claimed and disclosed by the applicant. As such, if the applicant's coating is "impregnatable", so is the coating of Farber et al. For further support of this position, please see Goepfert et al. (Col.3, lines 30 – 35), which teaches that a polyurethane material has an open structure and contains a colorant "therewithin" after a tinting operation (i.e., is "impregnatable"). Regarding (2) and (5), the examiner maintains that there is a motivation to combine the references found in the prior art, as well as a reasonable expectation of success. Briefly, Farber et al. does not explicitly teach that the polyurethane primer comprises an "impregnation composition", specifically a solution or dispersion, in a diluent medium, of an additive (e.g., a dye) to be incorporated. However, Farber et al. does teach that the protective hard (anti-scratch) coating (i.e., the coating on top of the polyurethane latex primer) can be tinted using a tinting bath at elevated temperatures, as is known in the art (Col.4, lines 55 – 59). Parker et al. teaches that, in the art of producing coated, tinted ophthalmic lenses (i.e., a process analogous to that of Farber et al.), either (1) the primer coating on the lens can be tinted and then coated with an untinted hard coating, or (2) the primer coating on the lens can be

untinted and then coated with a tinted hard coating (as taught by Farber et al.) (Col.5, lines 1 – 6). In other words, Parker et al. teaches the functional equivalence of (1) tinting the primer coating (i.e., the “impregnatable thin film”, as claimed by the applicant) and (2) tinting the hard top coating that overlies the primer coating (as taught by Farber et al.). The tinting material taught by Parker et al. comprises a solution or dispersion, in a diluent medium, of a dye (i.e., an additive) to be incorporated into the coating(s) (Col.5, lines 36 – 67, Col.7, lines 39 – 67, and Col.8, lines 1 – 8). Additionally, Parker et al. teaches that utilizing a tinted primer layer and a clear overlayer gives the impression of a deeper hue and higher gloss, which is desirable in some instances (Col.2, lines 44 – 54). Goepfert et al. teaches that, in the art of tinting polyurethane coatings on ophthalmic lenses, the tinting process is typically carried out by impregnating the coating with a solution or dispersion of a dye in a diluent medium (Col.3, lines 51 – 68, Col.4, and Col.5, lines 1 – 43). At the very least, one of ordinary skill in the art would have been motivated to impregnate the polyurethane latex primer coating of Farber et al. with an “impregnation composition” comprising a solution or dispersion of a dye in a diluent medium (so that the coating comprises the “impregnation composition”), as taught by Goepfert et al., in order to obtain similar results, regardless of whether the primer coating is tinted (as taught by Parker et al. and claimed by the applicant) or the hard top-coating is tinted (as taught by Farber et al.). In other words, since Parker et al. teaches that a lens can be tinted by either tinting the top coating or tinting the primer coating and then applying an untinted top coating, it would have been obvious to one

of ordinary skill in the art to tint either layer of the lens. Additional motivation to tint the primer layer is found in Parker et al.'s teaching that utilizing a tinted primer layer and a clear overlayer gives the impression of a deeper hue and higher gloss, which is desirable. One of ordinary skill in the art would have had a reasonable expectation of success in using an impregnation composition to tint the polyurethane primer of Farber et al. because Goepfert et al. explicitly teaches that such a tinting operation works for polyurethane coatings on spectacle lenses. Additionally, one of ordinary skill in the art would have been motivated to use an impregnation composition such as that of Goepfert et al. to tint the primer of Farber et al. because such a tinting process has the following advantages: (1) produces a homogeneous tint, (2) fixes the colorant within the coating, and (3) has the ability to control the level of tint (based on immersion time) (Col.3, lines 22 – 35, Col.5, lines 38 – 43).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D. Markham whose telephone number is (571) 272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WDM

Wesley D Markham  
Examiner  
Art Unit 1762



**TIMOTHY MEEKS**  
SUPERVISORY PATENT EXAMINER